

## **REMARKS**

This paper is filed in response to the Office Action dated July 17, 2003. As this paper is filed on November 17, 2003, and is accompanied by a petition for one-month extension and fee (\$110), the paper is timely filed.

### **I. Status of Amendments**

Claims 1-20 were pending prior to this amendment. By this amendment, applicants cancel claims 1-20, and add claims 21-49. Thus, claims 21-49 are now pending.

Because applicants previously paid fees for 3 independent and 20 total claims, applicants' amendments only require a fee of \$334 to pay for 2 additional independent claims and 9 additional claims in excess of 20.

### **II. Response to Office Action**

#### **A General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘ \_\_\_\_\_ ’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. Specification**

The specification has been amended to correct minor grammatical and typographical errors.

**C. The July 17 Office Action**

In the July 17 Office Action, claims 13 and 16 were objected to for alleged antecedent basis issues. The objections are moot due to the cancellation of claims 13 and 16 by this Amendment.

Additionally, claims 1-20 were rejected under 35 U.S.C. §112 as allegedly being indefinite. The rejections are moot due to the cancellation of claims 1-20 by this Amendment.

Further, independent claims 1, 8, and 18 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Nulph (U.S. Patent No. 6,234,899). Also, dependent claims 2, 3, 9-10, and 17 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Nulph. Moreover, dependent claims 4-7, 11-16, 19, and 20 were rejected as allegedly unpatentable over Nulph in view of McNabola (U.S. Patent No. 6,368,213). These rejections are also moot due to the cancellation of claims 1-20 in this Amendment. Nonetheless, the applicants have the following remarks regarding Nulph and McNabola.

In particular, independent claim 21 recites a multiple game entry form comprising a plurality of gaming spaces, each gaming space having a unique indicator and a plurality of selectable selection spaces associated with each of the gaming spaces. The number of selection spaces associated with each of the gaming spaces is fixed, and one of the selection spaces associated with each of the gaming spaces collectively defines one of a plurality of separate game sets.

Nulph does not disclose, teach or suggest all of the limitations of claim 21. Specifically, the allegedly corresponding "game spaces" ("Play A" and "Play B") and "selection spaces" (1-80) identified at page 4 of the July 17 Office Action with respect to Figure 3A do not meet the limitations of claim 21. That is, the spaces 1-80 in Play A collectively define a game that is separate from the game defined by the spaces 1-80 in Play B. No game set is defined according to spaces 1-80 of both Plays (i.e., of "Play A" and "Play

B"). Therefore, the above recited limitations cannot be met by Nulph, and there is nothing in Nulph that teaches or suggests such a limitation.

Likewise, McNabola does not disclose, teach or suggest all of the limitations of claim 21. At col. 3:33-40, McNabola does state (with reference to Figure 1):

To provide a means to play "ways", the device 10 includes a plurality of way buttons 26a-e designated as "Group 1" through "Group 5", etc. Alternatively, the way buttons 26a-e could designated as "Way 1" through "Way 5". Each group selected by the player denotes a way  $W_1$ - $W_N$  to be played by the player. As described below, to play ways the player will depress the way buttons 26a-e in sequence and designate the numbers of each way (W).

McNabola also states at col. 4:55-57 (with reference to Figure 3) that:

[T]he player's selections of each of the three ways includes a common, or king, number 42 of 56.

However, McNabola further states that the common, or king, number is displayed using a dynamic display. For example, in col. 2:35-40, McNabola states:

Where a number is a king number, i.e., is a number commonly used in a plurality of ways, the processor can control the display to distinguish the king number from the selected ways. The processor may control the processor to display the king number at [sic, as] bisected or trisected and each section including the color of a corresponding way.

As such, "the number of selection spaces associated with each of the gaming spaces being fixed" is not disclosed, taught or suggested by McNabola.

Furthermore, one of ordinary skill in the art would not combine Nulph and McNabola, because they teach away from each other and away from the claimed subject matter. Nulph shows playslips having two separate game grids printed thereon (i.e., "Play A" and "Play B"), and each of the game grids has a complete set of indicia for that game, as shown in Figures 3, 3C, 5, and 6. It is the applicant's belief that if a third game were to be included on Nulph's playslip, another game grid (e.g., "Play C") would be required, having its own complete set of indicia. McNabola, conversely, discloses a single game grid that dynamically displays a number of "ways." As such, the two references appear to teach or suggest different displays of game information, which are opposed to each other and teach away from the subject matter of, for example, claim 21, which recites a plurality of gaming spaces with a plurality of selectable selection spaces, the number of selection spaces associated with each of the

gaming spaces being fixed and one of the selection spaces associated with each of the gaming spaces collectively defining one of a plurality of separate game sets.

Furthermore, it is the applicant's position that the arguments made relative to claim 21 and Nulph/McNabola are applicable with equal force to new independent claims 31, 37, 43, and 49. Claim 31 recites language substantially similar to that recited in claim 21; therefore, the arguments above apply equally. Claim 37 recites, similar to claim 21, a selectable selection space disposed in each corner of each of a plurality of gaming spaces; the selection spaces disposed in one of the corners of each of the gaming spaces collectively defining one of a plurality of separate game sets; the arguments above should apply here as well. Additionally, claims 43 and 49 recite that each of a plurality of gaming spaces has four selectable selection spaces, a first selection space disposed in a first corner of each gaming space, the first selection spaces collectively defining a first game set, a second selection space disposed in a second corner of each gaming space, the second selection spaces collectively defining a second game set, a third selection space disposed in a third corner of each gaming space, the third selection spaces collectively defining a third game set, and a fourth selection space disposed in a fourth corner of each gaming space, the fourth selection spaces collectively defining a fourth game set. Here too, the arguments above suggest the allowability of the claims.

Finally, claims 22-30 depend from claim 21, claims 32-36 depend from claim 31, claims 38-42 depend from claim 37, and claims 44-48 depend from claim 43. Given that claims 21, 31, 37, and 43 are allowable, so too are the claims that depend from these claims. Consequently, the Examiner is respectfully requested to allow these claims.

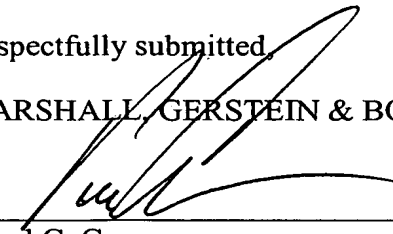
In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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